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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,236	04/07/2000	Aviel D. Rubin	1999-0727	1307

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/544,236	Applicant(s) RUBIN, AVIEL D.	
	Examiner Matthew Heneghan	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-18 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*Handwritten mark resembling a stylized 'R' or 'B'.*

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 20 September 2004 and 17 December 2004 have been entered.

2. In response to the previous office action, Applicant has amended claims 1, 6, 10, 11, and 22; cancelled claims 19 and 20; and added claims 23 and 24. Claims 1-18 and 21-24 have been examined.

### ***Drawings***

3. The drawings were received on 20 September 2004. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-9, 11-18, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,629,982 to Micali in view of U.S. Patent No. 5,633,916 to Goldhagen et al. further in view of U.S. Patent No. 5,926,506 to Kara.

Regarding claims 1 and 2, Micali discloses an electronic transaction system in which electronic signatures are attached to return receipts are sent to "Alice," the calling party (see column 12, lines 23-34), which also certifies the identity of the recipient, "Bob." Micali further states that the mail system uses computer networks, which inherently transmit message as a set of digitized packets (see column 4, lines 58-65).

Micali discloses the use of his invention for telephone, fax, broadcast, or other communications networks (see column 4, lines 58-65), but does not explicitly specify that messages may be voice or multimedia mail, or that messages be sent and received on customer premise equipment.

Goldhagen discloses a system a universal messaging system, wherein both multimedia and voice messages may be sent (see column 6, lines 4-32), and suggests that the "Universal Mailbox Service" enables Windows/PC-based applications to perform all the functions currently available to telephone-based NAP Voice and

Facsimile subscribers. Such messages, if transmitted digitally, comprise streams of packets.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of Micali as a "Universal Mailbox Service," as disclosed by Goldhagen, in order to enable Windows/PC-based applications to perform all the functions currently available to telephone-based NAP Voice and Facsimile subscribers.

Kara discloses the transmission of documents between clients at two PCs, which inherently receive digital packets and constitute customer premise equipment (see column 4, line 25 to column 10), and notes that in such electronic transmissions, authenticity is becoming more and more of an issue (see column 1, lines 9-11).

Therefore it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the protocol and functionality of Micali and Goldhagen into the system disclosed by Kara, as in such electronic transmissions, authenticity is becoming more and more of an issue.

As per claim 3, return certificates are being generated by the certification provider (the "Post Office").

As per claim 6, all such messages are being signed using an encryption key,  $E_A$  (see column 5, lines 10-20).

As per claim 9, Micali discloses that a signature may simply consist of a public key (see column 5, lines 30-35).

As per claims 11, 12, 14, the initial message sent by Alice to the Post Office is signed and includes a certificate (see column 11, line 62 to column 1, line 3).

As per claim 13, the Post Office acts as a judging system as well as a certifying system.

As per claims 21 and 22, Micali discloses that sessions may be initiated from telephones, faxes, etc., which would be off-network (see column 4, lines 59-62).

Regarding claims 4 and 5, the system disclosed by Micali does not incorporate a judging authority, but Micali discloses the use of a judging authority in a prior art system by Ben-Or et al., and further suggests that judging authorities reduce the probability that one party receives a contract, certifying the transaction, while the other does not.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Micali, Goldhagen, and Kara by adding a judging authority, in order to reduce the probability that one party receives a contract, certifying the transaction, while the other does not.

Regarding claim 7, Micali discloses that the sender ("Alice") must indicate that she is using an ICM (return receipt) transaction (see column 11, line 66 to column 12, line 3), but does not state that she is prompted for that information.

Official notice is given that it well-known in the art that computer programs may prompt users when determining whether or not to employ an optional feature.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the invention of Micali, Goldhagen, and

Kara by prompting Alice when determining whether or not to employ ICM, which is an optional feature.

As per claim 8, the return receipt received by Alice has been encrypted using Alice's key, and includes Bob's publicly verifiable signature (see column 4, line 66 to column 5, line 20 and column 12, lines 17-34), and is therefore verifiable by Alice.

Regarding claims 15 and 16, Micali discloses that Alice is a user, but does not discuss the network configuration being used by Alice.

Official notice is given that it is well-known in the art that in network communications, a user using a corporate network would be using a customer premises equipment system.

Official notice is also given that in corporate networks, it is well-known in the art that proxy servers are used to isolate the internal network from unwanted network traffic.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further implement the invention of Micali, Goldhagen, and Kara by having Alice use a corporate network, which would be a customer premises equipment system, and to implant on the corporate network a proxy server, in order to isolate the internal network from unwanted network traffic.

Regarding claims 17 and 18, Micali does not specify the type of system on which the Post Office or judging authorities are implemented.

Official notice is given that network utilities that is well-known in the art that network utilities that are simultaneously available to a large number of users are

implemented on servers, in order to allow for efficient, consistent service to all authorized users.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further implement the invention of Micali by using a server for the Post Office or judging authority, in order to allow for efficient, consistent service to all authorized users.

4. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,629,982 to Micali in view of U.S. Patent No. 5,633,916 to Goldhagen et al. further in view of U.S. Patent No. 5,926,506 to Kara as applied to claims 1 and 11 above, and further in view of U.S. Patent No. 6,327,656 to Zabetian.

NOTE: Zabetian was cited, but not relied upon, in the previous office action.

Micali, Goldhagen, and Kara do not address the disposition of extraneous header information during the compilation process.

Zabetian discloses a document certification apparatus wherein the certification module strips headers from a message being processed, and further notes that any portion of a message that is not to be certified should be removed (see column 7, lines 7-13).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the system of Micali, Goldhagen, and Kara by stripping headers during message processing, as disclosed by Zabetian, since any portion of a message that is not to be certified should be removed.



***Allowable Subject Matter***

5. Claim 10 is allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 10, No art could be found that suggested the sending of the entire digital voice mail message from the recipient as part of a return receipt. U.S. Patent No. 5,956,390 to McKibben et al. and previously cited U.S. Patent No. 5,629,982 to Micali both disclose the return of messages in their entirety, but only from an intermediate server, not the recipient. U.S. Patent No. 5,377,017 to Lam and U.S. Patent No. 6,477,243 to Choksi et al. each disclose the returning of an entire message from a recipient, but only for fax transmissions; no art could be found that suggested that the motivation for doing this with respect to a fax transmission would also apply to voice mail.

***Response to Arguments***

7. Applicant's arguments with respect to the rejections of claims 1-9, 11-18, 21, and 22 under 35 U.S.C. 103 have been fully considered and are persuasive in view of Applicant's amendment. Therefore, the rejection has been withdrawn. However, upon

Art Unit: 2134

further consideration, a new ground(s) of rejection is made in view of the art cited above.

8. Applicant's arguments with respect to the rejection of claim 10 have been fully considered and are persuasive in view of Applicant's amendment. The rejection of claim 10 has been withdrawn.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached at (571) 272-3838.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Art Unit: 2134

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH



April 14, 2005



**ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER**